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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,697	09/27/2006	Gerard Marguerie	0568-1010	3522
466 7590 02/03/2012 YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314				
EXAMINER				
FINN, MEGHAN R				
ART UNIT		PAPER NUMBER		
1629				
NOTIFICATION DATE		DELIVERY MODE		
02/03/2012		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

# Office Action Summary

**Application No.**

10/587,697

**Applicant(s)**

MARGUERIE ET AL.

**Examiner**

MEGHAN FINN

**Art Unit**

1629

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1, 6, 7 and 14-18 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1, 6-7, 14-18 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date 1/17/12

### **DETAILED ACTION**

Applicant's Amendment filed December 07, 2011 has been received and entered into present application. No claims were canceled or added by applicant. Thus claims 1, 6-7 and 14-18 are pending.

Applicants' arguments, filed December 07, 2011, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 6-7 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cai et al. (US 2003/0105140 A1) already of record, for the reasons set forth at pages 5-8 of the previous office action dated September 07, 2011 as well as pages 4-6 of the office action dated November 10, 2009 and pages 6-7 of the office action dated March 31, 2009, of which reasons are herein incorporated by reference.

Applicant has amended claims to overcome the USC 112 rejection, however the claim amendments to not change the applicability of the previous rejection over Cai et al. The claims still read upon a compound and a composition comprising the elected species, also known as CGP02-01. The previous rejection is herein incorporated by reference. Applicant has argued once again that Cai et al. teaches the compounds are useful for treating cancer diseases and does not suggest treating for diseases associated with lipid metabolism. As explained previously, the claims are drawn to compositions and compounds and the same compound/composition must necessarily be useful for the same diseases. The prior art is not required to teach the same reason for using the compounds as applicant intends to use them. Applicant has also argued that the elected species unexpectedly has the claimed activity and two other compounds from Cai et al. do not. Applicant references the declaration filed by Gerard

Marguerie filed March 10, 2010 with the previous which as explained in the previous office action fails to demonstrate unexpected results.

Applicant argues that according to Cai the particular aryl group does not affect activity when X is a sulfur atom because in claim 32 of Cai et al. the X is S and Ar1 is "optionally substituted aryl or heteroaryl". Cai et al. is not declaring that they would have exactly the same activities but that these compounds would be useful for treatment of cancer. It would not be unexpected to one of skill in the art that these compounds would have slightly different physical properties and additional activities. But more importantly, applicant has not demonstrated that these activities are in fact different. Applicant points to the declaration of March 10, 2010 which the inventor showed 2 compounds from Cai et al. and stated that "the compounds according to formula (I) of CAI, however, that do not share the claimed therapeutically activity" (page 2 of declaration). However applicant never provides any data or physical evidence of activity or lack of activity. It is merely the inventors opinion that these compounds showed no activity and that the elected species does have activity but there is no evidence of this. The examiner cannot determine what the activity of these compounds actually is other than the inventor's opinion that these compounds "do not share the claimed therapeutical activity". Applicant needs to submit evidence such as some form of testing data to compare the activity of these compounds in an accepted assay or model of the claimed therapeutic activity in order to demonstrate that there is in fact a difference in the activities of the elected species and other compounds of Cai et al. See MPEP 716.02 (b):

## **716.02(b)Burden on Applicant [R-2]**

### **I.< BURDEN ON APPLICANT TO ESTABLISH RESULTS ARE UNEXPECTED AND SIGNIFICANT**

The evidence relied \*>upon< should establish “that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance.” *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (Mere conclusions in appellants’ brief that the claimed polymer had an unexpectedly increased impact strength “are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration.”); *Ex parte C*, 27 USPQ2d 1492 (Bd. Pat. App. & Inter. 1992) (Applicant alleged unexpected results with regard to the claimed soybean plant, however there was no basis for judging the practical significance of data with regard to maturity date, flowering date, flower color, or height of the plant.). See also *In re Nolan*, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977) and *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) as discussed in MPEP § 716.02(c).

### **II.< APPLICANTS HAVE BURDEN OF EXPLAINING PROFFERED DATA**

“[A]ppellants have the burden of explaining the data in any declaration they proffer as evidence of non-obviousness.” *Ex parte Ishizaka*, 24 USPQ2d 1621, 1624 (Bd. Pat. App. & Inter. 1992).

In the instant case, applicant is attempting to establish that there is a difference in activity between several compounds encompassed by Cai et al., including the elected species. In order to demonstrate that the elected species unexpectedly has different activity from other compounds which would be considered equivalent in Cai et al., applicant must actually demonstrate a significant difference in activity with evidence that the examiner can actually evaluate. Without this information applicants arguments are not persuasive to establish that the elected species is unexpectedly different in activity from other compounds which Cai et al. would consider to be equivalent.

Applicant’s arguments have been carefully and fully considered however are not deemed persuasive and thus the rejection of claims 1, 6-7 and 14-18 is **maintained**.

***Conclusion***

Rejection of claims 1, 6-7 and 14-18 is deemed proper and is **maintained.**

No Claims of the present application are allowed.

**THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meghan Finn whose telephone number is (571) 270-3281. The examiner can normally be reached on 10:30am-7pm Mon-Friday (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Lundgren can be reached on 571-272-5541. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/MEGHAN FINN/  
Examiner, Art Unit 1629

/Jeffrey S. Lundgren/  
Supervisory Patent Examiner, Art Unit 1629